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Hewlett Packard Company
PO Box 272400
3404 E. Harmony Road
Intellectual Property Administration
Fort Collins, CO 80527-2400

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OFFICE OF PETITIONS

In re Application of :
McNamara et al. :
Application No. 10/020,729 : DECISION ON PETITION
Filed: December 12, 2001 :
Attorney Docket No. 200301830-1 :

This is a decision on the petition under 37 CFR 1.137(a),[1] filed on August 5, 2004, to revive the above-identified application, which is first being treated as a petition to withdraw the holding of abandonment.

The application became abandoned on November 18, 2004, for failure to respond timely to the final Office action mailed on August 17, 2004, which set a three-month shortened statutory period for reply. A Notice of Abandonment was mailed on May 16, 2005.

In the present petition, petitioners asserted that their failure to respond in a timely manner was unavoidable due to non-receipt of the final Office action. In support of the assertion, petitioners submitted a declaration of Maria Carroll, the Legal Administrator in charge of maintaining the corporate mail log for formal papers received by Hewlett-Packard Co. ("HP) from the USPTO, and a copy of HP's mail log of documents received from the USPTO during the period from August 15,

[1] A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

(1) The required reply to the outstanding Office action or notice, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance thereof. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) The petition fee as set forth in 37 CFR 1.17(l);

(3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

(4) Any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

2004 through August 31, 2004. Petitioners averred that these documents clearly show that HP did not receive the final Office action during the month period when the USPTO alleged it mailed the communication.

PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

A review of the record indicates no irregularity in the mailing of the final Office action, and in the absence of any irregularity in the mailing, there is a strong presumption that the Notice was properly mailed to the address of record as it existed on August 17, 2004. This presumption may be overcome by a showing that the Notice was not in fact received. The showing required to establish non-receipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.[2] For example, if a three month period for reply was set in the non-received Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the non-received Office action must be submitted as documentary proof of non-receipt of the Office action. The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g. if the practitioner has a history of not receiving Office actions).

The showing of record is insufficient to warrant withdrawal of the holding of abandonment. A review of the record indicates that the USPTO mailed the final Office action to Morgan, Lewis & Bockius, LLP, 2 Palo Alto Square, 3000 El Camino Real, Palo Alto, California, 94306, the address of record as of August 17, 2004. Moreover, after reviewing HP's docket records, it appears that the final Office action was mailed by the USPTO to Morgan, Lewis & Bockius, and thereafter, forwarded by that law firm to HP. Because the USPTO mailed the final Office action to Morgan, Lewis & Bockius, HP's docket records for that period are irrelevant. More importantly, in her Declaration, Ms. Carroll declared that her responsibilities included maintaining a corporate mail log of formal papers received from the USPTO "... addressed to the Hewlett-Packard Company, Intellectual Property Administration." *Declaration of Maria Carroll dated August 2, 2005, p. 1.* Accordingly, the Declaration of Ms. Carroll is not evidence of non-receipt because the final Office action was not addressed to Hewlett-Packard Company, Intellectual Property Administration.

To demonstrated non-receipt of the final Office action, petitioners must submit a copy of docket reports of Morgan, Lewis & Bockius, showing all replies docketed for a date three months from the mail date of the final Office action, as well as a statement from a practitioner at the law firm attesting to the fact that a search of the file jacket and docket records indicates that the final Office action was not received by the practitioner. Lastly, petitioners must show they did not lose the final Office action after it was received by Morgan, Lewis & Bockius, and thereafter, forwarded to HP. As petitioners

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[2] M.P.E.P. § 711.03(c); See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

have not presented the required showing, the petition to withdraw the holding of abandonment is dismissed.

REQUIREMENT FOR REPLY

It does not appear that petitioners submitted a response to the final Office action previously or with the present petition. The proposed reply required for consideration of a petition to revive **must** be a Notice of Appeal (and fee required by law), an amendment that prima facie places the application in condition for allowance, the filing of a continuing application, or a request for continued examination under 37 CFR 1.114 with a proper submission and fee. Before the application can be revived, petitioners must file a proper reply as required by the final Office action with any renewed petition. Petitioners may view the final Office action on PAIR, as the application has been published.

PETITION UNDER 37 CFR 1.137(a)

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable".[3] Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.[4]

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).[5] Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail,

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[3] 35 U.S.C. § 133.

[4] In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

[5] See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.[6]

A delay is not unavoidable when an applicant fails to comply with a requirement set forth in an Office communication, which necessitates a response within a specified time period. Additionally, petitioner did not demonstrate that the delay was unavoidable due to non-receipt of the Notice.

As previously stated, the written record indicates that the USPTO properly mailed the final Office action to the address of record as it existed on August 17, 2004. However, it appears that petitioners filed a change of correspondence address in this application on September 12, 2005. A belated notification to the USPTO of a change of correspondence address does not constitute proper notification as to establish unavoidable delay. An applicant is responsible for promptly informing the Office of any change of address. The Office further notes that where an application becomes abandoned as a consequence of a change of correspondence address (the Office action being mailed to the old, uncorrected address and failing to reach the applicant in sufficient time to permit a timely reply) an adequate showing of "unavoidable" delay requires a showing that applicant exercised due care to promptly notify the Office of the change of address and file a timely notification of the change of address in the application at hand.[5] Furthermore, a delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay.[6]

Because applicant did not provide a sufficient showing that the delay was unavoidable within the meaning of 35 U.S.C. § 151 and 37 CFR 1.137(a), the petition is **dismissed**. In any renewed petition under 37 CFR 1.137(a), petitioners must submit a thorough explanation, including any documentary evidence, to support a showing of unavoidable delay.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." Extensions of time are permitted under 37 CFR 1.136(a).

ALTERNATIVE VENUE

Petitioners are encouraged to consider filing a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application instead of filing a renewed petition under 37 CFR 1.137(a).

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[6] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

[5] MPEP 711.03(c)(III)(C)(2); See MPEP 601.03.

[6] See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

> (1) The reply required to the outstanding Office action or notice, unless previously filed. In nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.
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> (2) The petition fee as set forth in 37 CFR 1.17(m), **an additional** $1,500.00 for a large entity and $750.00 for a small entity;
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> (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
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> (4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

Further correspondence with respect to this matter should be addressed as follows and **to the attention of Senior Petitions Attorney Christina Tartera Donnell:**

By mail:	Mail Stop Petition Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450
By FAX:	(571) 273-8300 Attn: Office of Petitions
By hand:	Customer Service Window Randolph Building 401 Dulany Street Alexandria, VA 22314

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions